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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,141	01/16/2007	Hans Steinhuebel	2003P07137WOUS	5531
28204	7590	11/25/2008		
SIEMENS SCHWEIZ AG I-47, INTELLECTUAL PROPERTY ALBISRIEDERSTRASSE 245 ZURICH, CH-8047 SWITZERLAND			EXAMINER GONZALEZ, LUIS A	
			ART UNIT 3653	PAPER NUMBER
			MAIL DATE 11/25/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/562,141	<b>Applicant(s)</b> STEINHUEBEL, HANS	
	<b>Examiner</b> LUIS GONZALEZ	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080408, 20070116</u> .                                      | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1 and 2 are objected to because of the following informalities: Claims 1 and 2 are objected under 37 CFR 1.75 (i) that states “where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation”. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, MPEP, section 2173.05 (p) states, “A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.” Since claim 2 claims both an apparatus and the method steps of using the apparatus, these claims are indefinite. Correction is required.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 2 and 3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, claim 2 is directed to neither a

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"process" nor a "machine", but rather embrace or overlap two different statutory classes invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See, MPEP, section 2173.05 (p). In particular, claim 2 recites both a process and a machine.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4-6, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Blackwell et al. US 6,511,062.

Blackwell discloses an apparatus (FIG. 1) for singulating flat articles which are transported on-edge as a stack comprising:

a controllably driven conveyor (22);

a stack support (26);

a take-away station (14);

detectors (46T, 46B) with actuators (58T, 58B) projecting from a take-away reference plane (52) at different heights for determining the position of the frontmost article at particular contact pressures which are connected to a drive controller (18) of conveyor;

wherein the conveyor and the stack support are driven in a separately controlled manner;

wherein the stack support can be individually moved horizontally in a plane perpendicular to the take away reference plane using actuators/detectors for measuring the position of the frontmost article, which are also provided for measuring the stack pressure, and that the actuators of the conveyor and the stack support can be controlled as a function of the ascertained position of the frontmost article.

Regarding claim 4, Blackwell teaches wherein the stack support is pivotally mounted on a linear guide (28), the pivoting axis being horizontally oriented in a plane perpendicular to the take-away direction and the pivoting device being controllable in such a way that the front most articles in the stack viewed from the take-away station are fed in the required vertical orientation.

Regarding claim 5, Blackwell further teaches wherein distributed over the length of the articles in the stack there are provided a plurality of detectors with actuators (58T, 58B) disposed one above the other.

Regarding claim 6, Blackwell teaches wherein the jogging movements of the detectors with variable amplitude, frequency, and force can be generated.

Regarding claim 8, Blackwell teaches wherein the detectors with the actuators comprise linear motors with an integrated position measuring system, the motor current being used for force measurement.

Regarding claim 9, Blackwell teaches wherein the detectors with the actuators comprise linear motors with an integrated position measuring system, a force measuring' device being fixed to the head of the armature of the linear motor.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blackwell et al. 6,511,062 in view of Rabindran et al. US 5,934,666.

Blackwell does not teach wherein there are or more sensing rollers at the tips of the detectors.

Rabindram teaches a similar apparatus (FIG. 6) with a sensing element (350) that has a sensing roller (350) at the tip of the detector. The rolling surface allows less friction (the surface rolls with the movement of the sheet) to be exert on the stack as the sheet is being urged by a stack support. It would have been obvious to one of ordinary skill in art at the time the invention was made to modify Blackwell's sensing detector to include the sensing roller as taught by Rabindram in order to minimize the friction to the sheet stack, thus preventing double feed.

***Allowable Subject Matter***

10. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUIS GONZALEZ whose telephone number is (571)270-3094. The examiner can normally be reached on M-F 9:30-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/  
Supervisory Patent Examiner, Art  
Unit 3653

LAG